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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/785,630

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Alex Magary

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06/19/2006

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EXAMINER

POINVIL, FRANTZY

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|---------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/785,630 | MAGARY ET AL. | |
| | Examiner | Art Unit | |
| | Frantzy Poinvil | 3628 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-50, 59-74 and 83-118 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-50, 59-74 and 83-118 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 17-50, 59-74 and 83-118 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-50, 59-74 and 83-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Northington et al. (US Patent No. 6,128,602) in view of Tognazzini (US Patent No. 5,739,512).

As per claims 17-26, and 31-43, 45-50, 59-67, 69, 71-74, 83-92 and 95-118, Northington et al disclose a system and method of making financial transaction information available electronically to remote client terminals. The system and method comprise receiving financial transaction data for a plurality of distinct financial transactions. It should be noted that most financial transactions and types of financial transactions where a receipt is kept or donated to the customer or purchaser include a unique identifier identifying a particular financial transaction so as to differentiate that

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particular transaction from other financial transactions and also so as to better store and retrieve individual financial transactions. Furthermore, it should be noted that a bank's monthly statement includes a plurality of individual financial transactions having unique identifiers. Thus, these financial transactions include unique identifiers and purchasers names and/or codes and or addresses associated with each given transaction. Thus, the determining function is obvious to note with an instant glance or when referred to the database or storage which stores these financial transactions.

Applicant is directed to column 7, line 44 to column 8, line 40 of Northington et al. Northington et al also teach suppressing transmission of a paper based version of the consented respective financial data, sending an E-mail message directly to an E-mail address of the associated client which may be for incorporation into a financial software program (applicant is referring to column 10, lines 56 to 65, column 11, lines 4-10, column 5, lines 15-29). The client system and the server system communicate with one another over a secure connection via the Internet. The system performs comparison of logins, passwords and reconciliation of stored information with inputted information. See column 14, lines 11-23 and column 6, lines 52-64 of Northington et al..

Applicant has argued that Norhtington fails to also teach "determining as a function of each unique identifier, whether the associated client has consented to receiving the respective financial data electronically and if it is determined that the associated client has consented to receiving the respective financial data electronically, making the respective financial transaction data available to the associated client electronically".

In response, the Examiner disagrees with the applicant's assertion. It is noted that Northington states that "Remote terminal 110 provides user access to the system 100 enabling users to access information, administer accounts, control spending and other account activities, request reports, and perform other tasks. The functionality available to each user via remote terminal 110 may be customized with the needs of the entity and/or the user". See column 5, lines 40-56. Northington further states that a user may request a report or the report may periodically delivered to a user. See column 8, lines 1-18 of Northington. Thus, providing consent to receiving electronically financial information is suggested by Northington. Furthermore, it is noted that if the financial data relates to the buying/selling of securities, as noted in the applicant's specification, particularly page 3, lines 13-16, it is stated that "the SEC has developed a set of compliance regulations specifically for electronic delivery of financial information and requires that a user consent to having such information either delivered electronically or maintained electronically where a user can access it, e.g., through the Internet".

Furthermore, Tognazzini discloses a system and method for providing digital delivery of receipts to a customer. See the abstract. Tognazzini further states that a company conducting business with another company may opt for the automatic transfer of digital receipt. Tognazzini then states:

"By placing commercially available EDI software (320) as middleware between the computer and the incoming/outgoing data, it is possible to map the data contained within an EDI message to/from a company's internal databases. As long as both companies have agreed in advance on which EDI transaction sets (message structures) they intend to use, and have agreed what each data element

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means, it is possible for the computers to send and receive messages without human intervention. In the Figure, Company A's computer has sent a Purchase Order (330) to Company B's computer. Company B's computer has determined that the order can be fulfilled and has responded by sending an acknowledgment (340) to Company A's computer. Automated bank card authorizations are accomplished in the same manner and methodology is suitable for the generation, transmission and acknowledgment of electronic receipts."

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Tognazzini into Northington et al in order to allow the delivery of financial information electronically at a user's consent with the motivation of providing users with an authentic receipt of their financial transactions.

As per claims 28-31, 68 and 94, Northington et al do not explicitly state sending a consent change request and confirming the consent change request as being authorized. As per this limitation, Northington et al allow a user to periodically obtain information at will. Thus a user may also be willing to change the period to receive the information or the destination or the address or a person has to receive a receipt of related financial transactions. Furthermore, in the system of Tognazzini, the two companies may also be opted to change or modify their consent or agreement when a previous agreement expires. Thus, functions of receiving the consent change request, confirming the consent change request is authorized and storing the associated one of consent or non-consent with the respective transaction type would have been obvious to one of ordinary skill in the art to do in the combination of Northington et al and

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Tognazzini in order to acknowledge which entity that an authentic receipt or record of financial transactions should be transferred to.

The teachings of Northington et al. and Tognazzini are discussed above. As per claims 27, 44, 70, 93, the combination of Northington et al and Tognazzini does not explicitly state maintaining a record of each sent E-mail message that does not successfully reach its intended E-mail destination. However, both and Tognazzini Northington et al teach sending E-mail to client terminals. Also, most E-mail systems have an automatic features of identifying E-mails that are not read, open or reached a destination. Incorporating such a feature in the system of Northington et al. and Tognazzini would have been obvious to one of ordinary skill in the art in order to determine alternate means of communicating requested information to a requester. If a recipient has failed to receive an E-mail message, sending a paper-based representation of the financial transaction data associated with each unsuccessfully sent E-mail message would have been obvious to one of ordinary skill in the art to do in the system of Northington et al and Tognazzini in order to assure that the requester does receive the requested information.


Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-

6797. The examiner can normally be reached on Monday-Thursday from 7:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Frantzy Poinvil
Primary Examiner
Art Unit 3628

FP
June 7, 2006